UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
WORJLOH, JALATEE

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
Office Action Summary	09/749,174	KANNIAINEN, LIISA
	Examiner	**Art Unit**
	Jalatee Worjloh	3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1-40 and 51-63* .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-64* is/are pending in the application.

    4a) Of the above claim(s) *41-50* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40 and 51-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 04/18/2005 has been entered.

2.   Claims 1-40 and 51-63 have been examined.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-4, 11,12, 17, 19, 21-23,29, 33, 37,40, and 60-63 are rejected under 35

U.S.C. 102(e) as being anticipated by US Patent No. 6141653 to Conklin et al.

        Conklin et al. disclose a trusted server (i.e. multivariate negotiation system residing at the

sponsor site), the trusted server prepares a contract for transaction between a merchant system

(second user) and a buyer system (first user), sends the prepared contract to buyer system for

acceptance by a user of the buyer system and returns and accepted contract to the merchant

system wherein the merchant system initiates the transaction based upon the accepted contract,

wherein the trusted server is an impartial intermediary and does not operate on behalf of either

the merchant system or buyer system and a charging engine (i.e. multivariate negotiation system)

for calculating a charge to be paid to the merchant system by the user (see claim 1; col. 24, lines

5-9 and 41-44).

Referring to claims 2,37 and 63, Conklin et al. disclose the trusted server identifies

whether the merchant system has modified the contract (see col. 34, lines 52-60 automated

negotiations engine further recognizing any changes in the terms and storing in the storage space

the terms each terminal proposes... indicating any changes in the terms until a set of terms is

acted upon in a final manner by the deciding entity).

Referring to claims 4 and 33, Conklin et al. disclose the merchant system (i.e. participant

site) comprises a web server (see col. 18, lines 54-59; col. 22, line 62 - col. 23, line 9; install

special Web server software at all or some participant sites).

Referring to claims 11, 12, 23 and 40, Conklin et al. disclose the payment system wherein

the buyer system comprises a computer system coupled to the Internet and further comprising a

World Wide Web interface, the World Wide Web interface interfacing the buyer system and the

merchant system (see col. 17, lines 13-32 participants connect to community sponsor through the

Internet and multivariate negotiations engine system).

Referring to claims 17, 19, 29 and 31, Conklin et al. disclose the trusted server provides

authentication for the transaction to the buyer system, wherein the authentication for the

transaction comprises authentication of the merchant system (see col. 20, lines 52-65).

Referring to claims 21 and 22, Conklin et al. disclose at least one buyer system (i.e. first

user) for operation by a user desiring to purchase a product, at least one merchant system (i.e.

second user) configured for providing a user the product and sending charging data indicative of

a payment amount in consideration for providing the product and at least one payment system

(i.e. multivariate negotiation system residing at the sponsor site) including a trusted server and a

charging engine, for handling the negotiation of a contract for a transaction between the

merchant system and the buyer system, wherein the trusted server is an impartial intermediary

and does not operate on behalf of either the merchant system or the buyer system, and the

charging engine being adapted to receive and process the charging data for the payment (see

claim 1; col. 24, lines 5-9 and 41-44).

Referring to claims 60 and 61, Conklin et al. disclose a trusted server, the trusted server

configured to prepare a contract for a transaction between a merchant system and a buyer system,

the trusted server configured to send the prepared contract to the buyer system for acceptance by

a user of the buyer system, the trusted server configured to receive the accepted contract from the ·

buyer system and send the accepted contract to the merchant system whereby the merchant

system can initiate the transaction based upon the accepted contract, the trusted server further

configured to function as an impartial intermediary that does not operate on behalf of either the

merchant system or the buyer system, wherein the trusted server is configured to process

charging data representative of buyer charges received from the merchant system (see claim 1's

rejection above).

Referring to claim 62, Conklin et al. disclose the trusted server (see claim 60 above).

Conklin et al. do not expressly disclose the server validating a buyer signature associated with

the accepted contract. Conklin et al. system validates participants using various authentication

mechanisms (see col. 30, lines 52-53); therefore, the system is capable of managing modification

of contract terms. Further, "the recitation of a new intended use for an old product does not

make a claim to that old product patentable." In re Schreiber, 44 USPQ2d 1429 (Fed. Cir. 1997).

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

6.   Claims 5, 9,10, 13-16, 24-28, 38, 39 and 52 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Conklin et al. as applied to claims 1, 21 and 23 above, and further in view of

US Publication No. 2005/0108155 to Gallagher et al.

Referring to claims 5 and 24, Conklin et al. disclose merchant system and buyer system

(see claim 1 above). Conklin et al. do not expressly disclose an interface between the merchant

system and the buyer system, the interface including a Wireless Application Protocol (WAP)

server for the buyer system supporting WAP connection. Gallagher et al. disclose an interface

between the merchant system and the buyer system, the interface including a Wireless

Application Protocol (WAP) server for the buyer system supporting WAP connection (see

paragraph [0024] Each client typically runs a browsing program, such as Microsoft's Internet

Explorer, Netscape Navigator or the like, or a microbrowser such as a WAP enabled browser in

the case of a cell phone, PDA or other handheld wireless devices, allowing a user of client to

browse pages and forms available to it from find exchange servers). At the time the invention

was made, it would have been obvious to a person of ordinary skill the art to modify the system

disclose by Conklin et al. include an interface between the merchant system and the buyer

system, the interface including a Wireless Application Protocol (WAP) server for the buyer

system supporting WAP connection. One of ordinary skill in the art would have been motivated

to do this because WAP is a secure specification that allows users to access information instantly

via handheld wireless devices.

Referring to claims 9,10, 38 and 39, Conklin et al. a buyer system (see claim 1 above).

Conklin et al. do not expressly disclose the buyer system disclose a mobile terminal. Gallagher

et al. disclose the buyer system disclose a mobile terminal, wherein the mobile terminal

comprises a web-enabled mobile phone (see paragraph [0024] each client device could a cellular

telephone, personal digital assistant, laptop or an other device capable of interfacing directly or

indirectly with the Internet). At the time the invention was made, it would have been obvious to

a person of ordinary skill the art to modify the system disclose by Conklin et al. to include a

mobile terminal that comprises a web-enabled mobile phone. One of ordinary skill in the art

would have been motivated to do this because it effectively supports mobile communications and

transactions.

Referring to claims 13 and 25, Conklin et al. disclose the trusted server and buyer system

(see claim 1 above). Conklin et al. do not expressly disclose the trusted server receives payment

from the buyer system, confirms payment by the buyer system and prevents non-repudiation of

the transaction by the buyer system. Gallagher et al. disclose the trusted server receives payment

from the buyer system, confirms payment by the buyer system and prevents non-repudiation of

the transaction by the buyer system (see paragraph [0010] receiving a payment request from a

first user, the payment request including an amount of funds for transfer to an online account

associated with the first user and identification information including an e-mail address of the

payor. The method also typically includes the steps of automatically sending an e-mail

notification to the payor at the email address, the email notification including the amount of .

funds to be transferred to the first user, receiving a payment response form the payor indicating

acceptance or rejection of payment request). At the time the invention was made, it would have

been obvious to a person of ordinary skill the art to modify the system disclose by Conklin et al.

to include the trusted server receives payment from the buyer system, confirms payment by the

buyer system and prevents non-repudiation of the transaction by the buyer system. One of

ordinary skill in the art would have been motivated to do this because it ensures that the

transferred payment has been send and received by the parties claiming to have send and

received the payment.

Referring to claims 14 and 26, Conklin et al. disclose a charging engine (see claim 1

above). Conklin et al. do not expressly disclose the charging engine received charging data

representing billing information from the merchant system and transfers a charge amount to the

buyer system for payment by the buyer system. Gallagher et al. disclose the charging engine

received charging data representing billing information from the merchant system and transfers a

charge amount to the buyer system for payment by the buyer system (see paragraph [0008] the

system sends a payment request to the payor via an electronic message...thereafter, the amount

of funds are transferred to the payee.) At the time the invention was made, it would have been

obvious to a person of ordinary skill the art to modify the system disclose by Conklin et al. to

receive charging data representing billing information from the merchant system and transfers a charge amount to the buyer system for payment by the buyer system. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives payment for the service provided.

Referring to claims 15 and 27, Conklin et al. disclose a charging engine (see claim 14 above). Conklin et al. do not expressly disclose the charging engine converts the received charging data into another form ready to be transferred to the buyer system. Gallagher et al. disclose the charging engine converts the received charging data into another form ready to be transferred to the buyer system (see paragraph [0008]). Notice, once the system receives the charging data to transmits an email to the other party; thus, the data is being converted into an electronic mail message. At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the system disclose by Conklin et al. to include to convert the received charging data into another form ready to be transferred to the buyer system. One of ordinary skill in the art would have been motivated to do this do because it allows the data to be read in different formats.

Referring to claims 16 and 28, Conklin et al. disclose a trusted server (see claim 1 above). Conklin et al. do not expressly disclose the trusted server receives payment from the buyer system based upon the charge amount sent to the buyer system, confirms payment by the buyer system and signals to the merchant system that payment has been made. Gallagher et al. disclose the trusted server receives payment from the buyer system based upon the charge amount sent to the buyer system, confirms payment by the buyer system and signals to the merchant system that payment has been made (see paragraph [0008] The user enters an amount of funds owned and

contact information such as an e-mail address for the recipient of the payment request (payor).

The system sends a payment request to the payor via an electronic message. If the payor accepts

the payment request, the payor identifies an online account from which to transfer funds to the

payee. Thereafter, the amount of funds are transferred to the payee and the systems ends an email

notification or other electronic message to the payee indicating that the funds have been

received). At the time the invention was made, it would have been obvious to a person of

ordinary skill the art to modify the system disclose by Conklin et al. to receive payment from the

buyer system based upon the charge amount sent to the buyer system, confirms payment by the

buyer system and signals to the merchant system that payment has been made. One of ordinary

skill in the art would have been motivated to do this because it is an effectively means of

processing payments and it provides an indication that the merchant will receive payments for

the service provided.

Referring to claim 52, Conklin et al. disclose an electronic commerce system including a

charging engine (see claim 21 above). Conklin et al. do not expressly disclose the charging

engine processes the charging data in response to multiple events occurring in accordance with

the transaction. Gallagher et al. disclose the charging engine processes the charging data in

response to multiple events occurring in accordance with the transaction (see abstract). At the

time the invention was made, it would have been obvious to a person of ordinary skill the art to

modify the system disclose by Gallagher et al. to process the charging data in response to

multiple events. One of ordinary skill in the art would have been motivated to do this because it

confirms that the payer wants to make the payment before processing the data.

Claims 6-8, 20, 32, 34-36 and 51 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Conklin et al. as applied to claims 1 and 21 above, and further in view of US

Publication No. 2001/0037319 to Edwards et al.

Referring to claims 6-8 and 34-36, Conklin et al. disclose a payment system wherein the

charge is for a product (see claims 1 and 21 above). Conklin et al. do not expressly disclose the

product comprises at least a portion of a content source, wherein the product is a document or

multimedia object. Edwards et al. disclose a payment system wherein the charge is for a product

and the product comprises at least a portion of content source (see abstract; the financial function

further may handle all the financial arrangements for the sale or lease of the content between the

parties), wherein the product is a document or multimedia object (i.e. "digital content"). At the

time the invention was made, it would have been obvious to a person of ordinary skill the art to

modify the system disclose by Conklin to charge for a product and the product comprises at least

a portion of a content source. One of ordinary skill in the art would have been motivated to do

this provides a mechanism for electronic content distribution, thereby permitting quick and easy

distribution of digitized works.

Referring to claims 20 and 32, Conklin et al. disclose a payment system (see claim 1

above). Conklin et al. do not expressly disclose a financial compensation system, the financial

compensation system providing financial transaction support to the buyer system and the

merchant system for the transaction. Edwards et al. disclose a financial compensation system

providing financial transaction support to the buyer system and the merchant system for the

transaction (see paragraph [0022]). At the time the invention was made, it would have been

obvious to a person of ordinary skill the art to modify the system disclose by Conklin et al. to

include a financial compensation system providing financial transaction support to the buyer

system and the merchant system for the transaction. One of ordinary skill in the art would have

been motivated to do this because it provides sufficient customer service to the buyer and

merchant.

Referring to claim 51, Conklin et al. disclose a charging engine (see claim 21 above).

Conklin et al. do not expressly disclose the charging engine processes the charging data in

response to a single event occurring in accordance with the transaction. Edwards et al. disclose

the charging engine processes the charging data in response to a single event occurring in

accordance with the transaction (see paragraph [0014]). At the time the invention was made, it

would have been obvious to a person of ordinary skill the art to modify the system disclose by

Conklin et al. to charge data in response to a single event occurring in accordance with the

transaction. One of ordinary skill in the art would have been motivated to do this because it

quickly processes charge data by eliminating multiple events.

7.   Claims 18 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin

et al. as applied to claims 17 and 30 respectively above, and further in view of US Publication

No. 2001/0056395 to Khan.

Conklin et al. disclose a payment system (see claim 17 above). Conklin et al. do not

expressly disclose the transaction comprises authentication of the product. Khan discloses the

transaction comprises authentication of the product (see claim 57). At the time the invention was

made, it would have been obvious to a person of ordinary skill the art to modify the system

disclose by Conklin et al. to authentic a product. One of ordinary skill in the art would have

been motivated to do this because it provides security; thus, preventing fraudulent activities.

8.   Claims 53-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conklin et

al. and Gallagher et al. as applied to claim 21 above, and further in view of US Patent No.

6064987 to Walker et al.

Referring to claims 53 and 54, Conklin et al. disclose an electronic commerce system (see

claim 21 above). Conklin et al. do not expressly disclose the charging engine processes the

charging data to cause the payment to be made in multiple increments. Walker et al. disclose the

charging engine processes the charging data to cause the payment to be made in multiple

increments, wherein the multiple increments respectively correspond to multiple events, each of

the multiple events occurring in accordance with the transaction (see col. 11, lines 57-65). At the

time the invention was made, it would have been obvious to a person of ordinary skill the art to

modify the system disclose by Conklin et al. to process the charging data to cause the payment to

be made in multiple increments. One of ordinary skill in the art would have been motivated to do

this because it provides faster means for data transmission.

Referring to claim 55, Conklin et al. disclose a buyer system (see claim 54 above).

Conklin et al. do not expressly disclose the buyer system is adapted to terminate at least a portion

of the multiple events and cause the charging system to cease processing of the charging data.

Gallagher et al. disclose the buyer system is adapted to terminate at least a portion of the multiple

events and cause the charging system to cease processing of the charging data (see paragraph

[0008]; The payor may cancel the transaction at any time until the payee directs the received

funds to an online account). At the time the invention was made, it would have been obvious to

a person of ordinary skill the art to modify the system disclose by Conklin et al. to terminate at

least a portion of the multiple events and cause the system to cease processing of the charging

data. One of ordinary skill in the art would have been motivated to do this it provides an

effective means for canceling transactions.

Referring to claims 56-59, Conklin et al. disclose a merchant system and a buyer system

and merchant offering (see claim 54 above). Conklin et al. do not expressly disclose the buyer

system is adapted to cease further buying of subsequent merchant offerings after the charging

system has processed the charging data for previous merchant offerings or the charging system is

adapted to terminate subsequent buying of the merchant offering after processing the charging

data for previous merchant offerings in response to a command received from the merchant

system/buyer system. Gallagher et al. disclose the buyer system canceling the transaction (see

paragraph [0008] The payor may cancel the transaction at any time until the payee directs the

received funds to an online account). Notice, the above systems are all capable of performing

the intended use feature; therefore, "the recitation of a new intended use for an old product does

not make a claim to that old product patentable." In re Schreiber, 44 USPQ2d 1429 (Fed. Cir.

1997).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Jalatee Worjloh whose telephone number is (571)272-6714. The

examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (571)272-6712. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306 for Regular/After

Final Actions and (571)273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
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Jalatee Worjloh
Patent Examiner
Art Unit 3621

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June 14, 2005

SALVATORE CANGIALOSI
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